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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,485	01/20/2006	Raphael Cohen	0820819.00143	1917
545	7590	11/05/2008	EXAMINER	
IP Patent Docketing K&L GATES LLP 599 Lexington Avenue 33rd Floor New York, NY 10022-6030			REESE, DAVID C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,485	Applicant(s) COHEN, RAPHAEL	
	Examiner David C. Reese	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 9/8/2008.

- Claims 2-3, 5-16 were canceled.
- Claims 17-19 were added.
- Claims 1, 4, were amended.
- Claims 1, 4, and 17-19 are pending.

Drawings

[1] The drawing(s) were previously objected for informalities. In view of Applicant's amendment to the claims submitted on 9/8/2008, all previous objection(s) to the drawings have been withdrawn.

Claim Objections

[2] Claim(s) 1-3 and 7 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 9/8/2008. Accordingly, the objection(s) to the claim(s) 1-3 and 7 have been withdrawn.

However, as amended:

[3] Claim 17 is objected to because of the following informalities: what structure is delineated by a bezel facet of a brilliant-cut stone?

Appropriate correction is required.

[4] Claim 17 recites the limitation "the bezel facets" in the instant claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

[5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claims 1, 4, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leveridge, FR-585,940, in view of Ramot, US-5,123,265, in further view of Monnier, US-2,207,869.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Leveridge discloses of an item of jewelry (see figs. 4-5) consisting of a central stone (3), the central stone (3) comprising a pavilion, a crown having a plurality of crown facets and a table and having the shape of a regular polygon, the polygon having a plurality of sides when observed from the table of the central stone (3), and a corresponding plurality of peripheral stones (1, 2), arranged around the central stone with the length of an edge of one of the sides of each of the peripheral stones being identical to the length of one of the sides of the regular polygon, each peripheral stone (1,2) having at least one peripheral stone facet, wherein the central stone (3) and the peripheral stones (1,2) are arranged on a support comprising a first ring (8) concentric with and connected to a second ring (6) having a top edge, each peripheral stone (1,2) also being located in position by a slot (see 8 in fig. 2) formed on the inside of the

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perimeter of the second ring (8), to simulate the appearance of the crown of a stone larger than the central stone.

The difference between the claim and Leveridge is that Leveridge does not expressly state that of a T-shaped shoulder on said top edge with one side of the T-shaped shoulder being configured to be snapped into a longitudinal groove extending entirely around the circumference of the pavilion of the central stone and with the other side of the T-shaped shoulder being snapped into a groove present in each peripheral stone; and of the at least one facet of each peripheral stone having an angle of incidence to the table of the central stone equal to the angle of incidence of an adjacent crown facet to the central stone.

With regard to the former issue, Ramot discloses a gemstone setting similar to that of Leveridge. In addition, Ramot further teaches of the setting have T-shaped shoulders on its top edge with one side designed to be snapped into a corresponding longitudinal groove passing of one stone and its other side snapped into a groove present in another adjacent stone. It would have been obvious to one of ordinary skill in the art, having the disclosures of Leveridge and Ramot before him at the time the invention was made, to modify the central ring setting, 6, of Leveridge to include a T-shaped shoulder at its top edge, as in Ramot. One would have been motivated to make such a combination because such a configuration allows for an alternative means for setting the central and peripheral stones, said configuration fixing the gemstone or gemstones in a manner which is very secure and stable and in which the setting is also substantially invisible, as taught by Ramot (see background of the invention). Further, it would have been obvious to a person of ordinary skill in the art to have modified the central ring as a person with ordinary skill has good reason to pursue the known options within his or her

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technical grasp. In turn, because the T-shape as claimed has the properties predicted by the prior art, it would have been obvious to modify the central ring of Leveridge in order to gain the commonly understood benefits and applications of such an adaptation and/or modification including that of a more stable and secure connection as well as helping to further hide said setting from view from the user. Thus, Leveridge as modified by Ramot teaches of the central ring 6 of Leveridge as having a T-shaped shoulder at its top as shown by Ramot, said central stone and the adjacent side of the peripheral stones being connected by said T-shaped shoulder. Further, though Leveridge does not disclose of the central stone having a groove passing all the way around the circumference its pavilion, Ramot, as shown in Fig. 1, discloses a groove around in the entirety of the gemstone for securement around all sides of said gemstone with the T-shaped shoulder.

With regard to the second issue, Monnier discloses a gemstone setting similar to that of Leveridge in view of Ramot. In addition, Monnier further teaches table of each peripheral stone and one of the facets of the crown of the octagonal central stone have an identical angle of incidence (see fig. 7 of Monnier). It would have been obvious to one of ordinary skill in the art, having the disclosures of Leveridge in view of Ramot and Monnier before him at the time the invention was made, to modify the angle at which the central and peripheral stones are arranged with respect to one another to have each peripheral stone and one of the facets of the crown of the central stone to have an identical angle of incidence, as in Monnier. One would have been motivated to make such a combination because one would want that exact design configuration for mere user preference and aesthetics; giving the effect of an extension of the central stone, as taught by Monnier (see col. 1, lines 30-35)

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Re: Claim 4, Leveridge teaches that the central stone is an octagonal stone and the plurality of peripheral stones comprises eight trapezoidal stones arranged around it (see fig. 5).

Re: Claim 17, wherein each crown facet (3) and a facet of a corresponding adjacent peripheral stone (1, 2), considered together, simulate one of the bezel facets of a brilliant-cut stone.

Re: Claim 18, wherein the first ring (8) and the second ring (6) are both circular (see figs. 4-5).

Re: Claim 19, wherein the first ring (8) and the second ring (6) have bases (in view of the bottom of 172 of Ramot) and the first (8) and the second ring (6) are connected at their bases by a number of converging arms (172) arranged at regular intervals around the rings (8, 6).

Response to Arguments

[7] Applicant's amendments and arguments filed 9/8/2008 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. To begin, the applicant argues that Leveridge does not appear to disclose the use of concentric rings as a support for the claimed arrangement of precious stones. The examiner disagrees and directs applicant to figures 4-5 of Leveridge. Continuing, the applicant argues that Leveridge's rods 6 do not appear to provide a ring which is great in height than another, larger ring. Again, the examiner disagrees and directs applicant to figure 2 of Leveridge where 6 is indeed shown as being greater in height (say from the bottom of the setting) than 8 is.

Continuing with applicant's arguments, applicant states that Ramot does not possess T-shaped shoulders on the top edge of a support ring. First, Ramot does indeed possess T-shaped shoulders on the top edge, and further, the prior art of Ramot was not used to show features of a

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support ring. In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

With regard to applicant's arguments concerning the prior art of Monnier, the examiner would first like to point out that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from appellant's disclosure, reconstruction is proper. *In re McLaughlin* 170 USPQ 209. Secondly, the examiner in the instant case is not using the prior art of Monnier for a teaching of replacing the rectangular stone of Monnier with a regular polygon; the prior art of Monnier was used to show the prevalence in the art of having a table of each peripheral stone and one of the facets of the crown of the octagonal central stone have an identical angle of incidences. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F. 2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

The determining of obviousness does not require staying within the object of Leveridge. "The question is not whether the combination was obvious to the patentee but whether the

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combination was obvious to a person with ordinary skill in the art." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007). In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*, 127 S.Ct. at 1742. 82 USPO2d at 1397.

Conclusion

[8] THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

[9] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese

/D. C. R./

Examiner, Art Unit 3677

/Victor Batson/

Supervisory Patent Examiner, Art Unit 3677